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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,537	07/27/2001	Tamra L. Thomason	10004747-1	8559

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HEWLETT-PACKARD COMPANY
Intellectual Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

BLACKWELL, JAMES H

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/916,537	Applicant(s) THOMASON, TAMRA L. SL	
	Examiner James H Blackwell	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 6, 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Berger et al. (hereinafter Berger, U.S. Patent No. 6,112,986).

In regard to independent Claim 1 (and similarly independent Claim 9), Berger teaches a method and apparatus for accessing patient insurance information. Patient information is stored on a "MEDICOMPUCARD" (see Fig. 1) that is received by inserting the card into a card reader (186) connected to a computer (see Fig. 3). Here, the location of the information to be added to the form is encoded on the card, the specific location depending on the format of the encoding (Col. 6, lines 25-38; Col. 7, lines 6-12; compare with Claim 1 (and similarly Claim 9), "**... receiving location information for user information to be added to a form**"). The card reader then reads the form information off the card. In order to capture the data stream, the receptionist scanning the card may invoke a simple text editor or other utility capable of accepting a continuous text stream (Col. 8, lines 11-24; compare with Claim 1 (and similarly Claim 9), "**... retrieving the user information**"). After saving the text file, now containing all

of the patients data, a custom script must be executed to import this data into the existing office database (Col. 8, lines 24-26; compare with Claim 1 (and similarly Claim 9), “... **configuring the user information for merging with the form**”). The patient data can then be printed out onto a standard medical form that contains most if not all the user information (note that some other fields may be blank (Col. 9, lines 23-29; Fig. 9; compare with Claim 1 (and similarly Claim 9), “... **and printing a form that contains at least a portion of the user information**”).

In regard to dependent Claim 2 (and similarly dependent Claim 10), Berger teaches that the location of the information to be added to the form is encoded on the card, the specific location depending on the format of the encoding (Col. 6, lines 25-38; Col. 7, lines 6-12; compare with Claim 2 (and similarly Claim 10), “... **the location information is received by reading a data card of the user**”).

In regard to dependent Claim 6, Berger teaches that after saving the text file, now containing all of the patients data, a custom script must be executed to import this data into the existing office database (Col. 8, lines 24-26). Berger also teaches that the patient data can then be printed out onto a standard medical form that contains most if not all the user information (note that some of the fields may be blank) (Col. 9, lines 23-29; Fig. 9; compare with Claim 6, “... **the step of merging the user information by populating form data fields**”).

Claims 14, and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Chan et al. (hereinafter Chan, U.S. Patent No. 6,378,070).

In regard to independent Claim 14, Chan teaches a secure printer (140) containing a central processing unit (CPU) (200) that controls a print engine (210) (Col. 4, lines 20-23). Chan also teaches that the printer has a Read Only Memory (ROM) (220), a Non Volatile Memory (230), and main memory (240). The main memory is for, among other things, used to store print jobs sent to the printer (which could include forms data) (Col. 4, lines 20-47; compare with Claim 14 features, “... **printing hardware with which hardcopy documents can be generated**” and “... **device memory that stores forms data**”. Chan also teaches that the printer contains a smart card reader (280) for reading information on a smart card (Col. 4, lines 42-47; compare with Claim 14, “... **a card reader that is adapted to read data from a user data card**”). Chan also teaches that the printer is connected to a network (110) (Col. 7, lines 55-61; compare with Claim 14, “... **a network interface device that is adapted to transmit and receive data via a network**”).

In regard to dependent Claims 19-20, Claims 19-20 reflect the printing device as claimed in Claim 14, and are rejected along the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger in view of Takagawa et al. (hereinafter, Takagawa, U.S. Patent No. 6,987,612).

In regard to dependent Claim 3, Berger does not specifically teach that *the location information comprises a universal resource locator (URL)*. However, Takagawa teaches an Internet accessing system that utilizes two cards and readers. One card contains information about an Internet access point telephone number, the ID number of the user, and the password of the user. The second card contains information about the URL designating the location of the desired startup homepage (see Abstract). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Berger and Takagawa because both inventions use card(s) and reader(s) to automatically convey user information to a system, preventing the user from having to remember the information and then manually entering the information with the potential of making mistakes thereby wasting time.

In regard to dependent Claims 7 and 8, Berger does not teach either *confirming authorization to access the user information* or *receiving a correct pass code*. However, Takagawa teaches an Internet accessing system that utilizes two cards and readers. One card contains information about an Internet access point telephone number, the ID number of the user, and the password of the user. By using these cards, the receiving system allows the user access to the Internet and to their homepage (see Abstract). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Berger and Takagawa because both systems use data cards for the purpose of transferring information to a system. Adding Takagawa provides the benefit of additional security using a username/password and having that information on a card rather than having to remember it or write it down.

Claims 4-5, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger in view of Harper et al. (hereinafter Harper, U.S. Patent No. 6,651,060).

In regard to dependent Claims 4 and 5, Berger fails to specifically teach either *retrieving the user information from a remote location via a network* or *the network comprises the Internet*. However, Harper teaches a data processing center for processing requests for medical records. (Col. 10, lines 41-65). As illustrated in Fig. 3, at least some of the communications between the various parties are carried out by means of the Internet (Col. 13, lines 15-17). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Berger and

Harper because both involve operations with medical records. Although Berger does teach the electronic transfer of insurance information to insurance companies, it makes no specific mention of a network connecting the doctor's office with the insurance company, with the exception of using a fax machine to transfer information to the insurance company. The benefit of Harper would have been to add the Internet as a network infrastructure thereby allowing the receipt and transfer of patient information between doctor's office and insurance company.

In regard to dependent Claims 11 and 12, Berger does not teach either *a network interface device or the network interface device is adapted to transmit and receive data via the Internet*. However, Harper teaches a network interface (74) connected to a local area network and a serial port interface (56) connected to a modem accessing a wide area network (see Fig. 1). Harper also teaches, as illustrated in Fig. 3, that at least some of the communications between the various parties are carried out by means of the Internet (Col. 13, lines 15-17). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Berger and Harper because both involve operations with medical records. Although Berger does teach the electronic transfer of insurance information to insurance companies, it makes no specific mention of a network or network interface device connecting the doctor's office with the insurance company, with the exception of using a fax machine to transfer information to the insurance company. The benefit of Harper would have been to add the Internet as a network infrastructure thereby allowing the receipt and transfer of patient information between doctor's office and insurance company.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berger.

In regard to dependent Claim 13, Berger teaches the act of printing insurance and information forms (see Fig. 8) making it obvious to one of ordinary skill in the art at the time of invention that a printer was being used as part of the system, providing the benefit of providing hardcopy to patients and insurance companies.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Takagawa.

In regard to dependent Claim 15, Chan teaches that the printer contains a smart card reader (280) for reading information on a smart card (Col. 4, lines 42-47; compare with Claim 14 “... ***the card reader is adapted to read information from a magnetic strip of the user data card***”. Chan does not teach any details of the smart card (specifically if it contained a magnetic strip) to store data. However, Takagawa teaches a system using two card readers and two cards. One of the cards contains a username and password. This information can be stored on an integrated circuit (similar to a smart card), or a magnetic stripe (Col. 4, lines 11-15). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Chan and Takagawa, because both utilize card readers as a security device, providing the benefit of privileged access to systems and resources.

Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan.

In regard to dependent Claim 16, Chan teaches that when a recipient's smart card is inserted into the printer's card reader, the identity taken from the card is transmitted to a print server (130). The print server uses the identity to search for and retrieve documents intended for the recipients (see Abstract; compare with Claim 16, **"... the network interface device is adapted to retrieve user information via the network"**). Chan fails to specifically teach *merging it with the forms data stored within device memory*. However, Chan does teach that the printer contains a main memory that is used for, among other things, to store print jobs sent to the printer (which could include forms data) (Col. 4, lines 29-47). This would have made it obvious to one of ordinary skill in the art at the time of invention to store and assemble forms data in the printer memory, providing the benefit of saving storage space on the sender's computer by using the printer to store and assemble the print jobs.

In regard to dependent Claims 17 and 18, Chan does not teach either a *network browser* or that *the network browser is an Internet browser*. However, Chan does teach that the secure printer contains many of the features essential to a computer (see Fig. 2). In addition, Chan teaches a network interface (250), various sensors (260), and a front panel display and keypad (270) all connected to the CPU via the system bus (205) (Col. 4, lines 20-41). It would have been obvious to one of ordinary skill in the art at the time of invention to have included network indicators, such as status, to the front panel display, as well as to allow interaction with the network via the keypad, thus providing a

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simple way to "browse" the network, be it the Internet or other type of network. The benefit would have been to provide communications between the secure printer and other devices also connected to the network.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Blackwell whose telephone number is 703-305-0940. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
07/29/04


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER